#13 Reply Brief 6/14/01 [illegible]

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Reitz et al.	
Applic No.: 09/433,202	
Filed : November 4, 1999	Group Art Unit: 1755
For : PARTICLE DISPERSIONS	Examiner: M. Marcheschi
Docket No.: N19.12-0026	

REPLY BRIEF

I HEREBY CERTIFY THAT THIS PAPER IS BEING SENT BY U.S. MAIL, FIRST CLASS, TO THE ASSISTANT COMMISSIONER FOR PATENTS, WASHINGTON, D.C. 20231 THIS 13 DAY OF June, 2001.
Robert J. Patch
PATENT ATTORNEY

BOX AF
Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

This is a Reply Brief under 37 C.F.R. §1.193(b)(1) in response to the Examiner's Answer mailed May 4, 2001. Applicants note that the Examiner in the Examiner's Answer only included one basis for the rejection under 35 U.S.C. §103(a), and all comments are directed to the rejection under 35 U.S.C. §103(a) over U.S. Patent 5,389,194 to Rostoker et al. in view of U.S. Patent 5,935,278 to Ishitobi et al. and U.S. Patent 6,001,730 to Farkas et al. Applicants/Appellants reply to two issues raised by the Examiner in the Examiner's Answer. First, issues raised by the Examiner regarding the disclosure in the Rostoker '194 patent are discussed in detail. Second, Applicants comment on the provisional obviousness-type double patenting rejection. The legal standards were discussed in detail in Applicants' Appeal Brief and are incorporated herein by reference.

REMARKS

Rejections Over Rostoker et al., Ishitobi et al., and Farkas et al.

With respect to U.S. Patent 5,389,194 to Rostoker et al. (the Rostoker patent), Applicants believe that the distribution described by the Rostoker patent is not clear with respect to

particle sizes. Regardless, Applicants have presented **unrefuted** evidence that the Rostoker patent does not teach methods for the production of particles having the properties claimed by Applicants. Since the Rostoker patent does not place the invention in the hands of the public, the Rostoker patent does not render the present invention obvious.

In view of Applicants' arguments that the distribution in the Rostoker patent could not be evaluated, the Examiner indicates that the distribution is clear such that no explanation of the distribution is necessary. The argument by the Examiner seems disingenuous since if the distribution was clear, an explanation by the Examiner would require little or no effort. Since the Examiner did not make this effort, Applicants have little basis for further evaluating the rejection over the Rostoker patent.

The Examiner now takes the position that the Rostoker patent covers a distribution with a zero width. However, the distribution is stated to be a Gaussian distribution, see column 7, lines 12-15. Gaussian distributions have a form of $N(D) = A \exp\{-[(D-X)/2B]^2\}$. Gaussian distributions do not have sharp cut-offs, but gradual cut offs. In fitting a particle size distribution curve to a Gaussian, it is clearly an imperfect fit since negative values of particle size are undefined. Similarly, real distributions clearly are not perfectly symmetric about the average particle size, but Gaussian distributions are symmetric. The tail of a Gaussian distribution extends to infinity, but the relationship between the tail of a Gaussian distribution and a real distribution may not be clear and is not clear in this context.

Assuming arguendo that the Rostoker patent does disclose a distribution extending down to a zero width, Applicants have presented unrefuted evidence that the Rostoker patent does not teach a method for producing particles disclosed and claimed by Applicants. This evidence includes an analysis of the Siegal patent (5,128,081) and related articles. The Examiner notes that

the Rostoker patent does not indicate that the Siegal patent describes the only way of making the particles. However, the Siegal patent **does not disclose** any other way of making the particles and does not exemplify particles with the properties disclosed and claimed by Applicants **or any actual particles.**

The Examiner further argues that the Declaration by Dr. Kambe does not show any evidence rebutting obviousness. Dr. Kambe is extremely experienced in the field, and his unrefuted declaration, therefore, provides significant evidence for patentability. The Examiner has had ample opportunity to rebut the evidence provided in the Kambe Declaration with articles or patents to the contrary but has not done so.

In reply, the Examiner takes the position that the particles described in the Rostoker patent must have been produced by some method. **This position has no basis whatsoever since the Rostoker patent does not present any actual examples. The Examiner seems to have a misunderstanding that the prophetic examples in the Rostoker patent are actual examples. But this is simply incorrect.**

Since Applicants have presented evidence regarding the lack of teaching in the Rostoker patent of methods for production of particles disclosed and claimed by Applicants, Applicants have overcome by a preponderance of the evidence any prima facie obviousness of the claims. Nevertheless, Applicants further maintain that the Examiner has not established prima facie obviousness.

Obviousness-Type Double Patenting Rejections

The Examiner argues that the rejection is not ripe for review since the rejection is only a provisional rejection. Applicants believe that for the sake of judicial economy, the obviousness-type double patenting rejections should be considered now rather than requiring a separate appeal later. Applicants note

that pending application 08/961,735 has been allowed and will likely issue before the consideration of this appeal.

The Examiner argues that the copending claims define distributions that broadly read on the claimed distributions, even though the Examiner admits that the distributions are not literally defined. Applicants do not believe that the Examiner has presented a cogent argument of why the distributions are obvious in view of the fact that the distributions are not literally described. Furthermore, there is no basis for a method of producing the claimed subject matter from the claims of the copending applications.

CONCLUSIONS AND REQUEST FOR RELIEF

Applicants submit that claims 1-28 and 31 are unobvious over the prior art of record. Applicants believe that the Examiner has failed to establish prima facie unpatentability of any of the claims. To the extent that the Examiner has provided a prima facie showing of unpatentability, Applicants have provided adequate evidence to establish patentability over the issues of record. Thus, Applicants respectfully request the reversal of the rejections of claims 1-28 and 31 and the allowance of claims 1-28 and 31.

The Director of the Patent and Trademark Office is authorized to charge any fee deficiency required by this paper or credit any overpayment to Deposit Account No. 23-1123.

Respectfully submitted,

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